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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/740,077	12/17/2003	Jason K. Shiepe	PES-0059C	1382

23413 7590 07/26/2005

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EXAMINER

CANTELMO, GREGG

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/740,077

Applicant(s)

SHIEPE ET AL.

Examiner

Gregg Cantelmo

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/12/04; 8/30/04; 4/28/05 MC
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

A review of the instant application and the disclosure of the parent application reveal that the parent application lacks sufficient disclosure to comply with the requirements of the first paragraph of 35 U.S.C. 112. Various claimed elements and disclosure in the later-filed application such as paragraphs {0006}-[0009] and claim limitations to elements f and g are not sufficiently supported by the disclosure of the parent application. Furthermore the instant application includes additional Figs. 7-13 and disclosure related to these figures whereas the parent application only includes Figs. 1-6.

Information Disclosure Statement

2. The information disclosure statements filed March 12, 2004, August 30, 2004 and April 28, 2005 have been placed in the application file and the information referred

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to therein has been considered as to the merits. Note that the inventor Zagala in the IDS filed March 12, 2004 has been corrected to Zagaja.

Oath/Declaration

3. The oath/declaration is defective since it makes an invalid claim as a continuation of application Ser. No. 09/065,680.

Specification

4. The disclosure is objected to because of the following informalities: Applicant's claim as a continuation of application Ser. No. 09/065,680 has not been granted since the parent application does not comply with the requirements of the first paragraph of 35 U.S.C. 112. Therefore the first sentence of the instant application is objected to since the priority claim is not valid. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2002-27851 A2 (WO '851).

Given that the claim to priority has not been granted, WO '851 qualifies as prior art under 35 U.S.C. 102(b).

WO '851 discloses an electrochemical cell comprising a PEM 202 having a first face and second face, anode 204 and cathode 206 on respective first and second sides

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of the PEM 202, metal screen 218 defining a first fluid cavity placed in contact with anode 204, compression pad 230 defining a second fluid cavity which is electrically conductive and has an inner face in contact with cathode 206, means 212 and 232 for axially containing fluid in the metal screen and compression pad and means 216/214 and 224/226/236 for peripherally containing fluid within said screen and compression pad (Admitted prior art Fig. 2 as applied to claims 1).

The compression pad includes carbon (page 8 as applied to claim 2).

The pad has a thickness of about 0.005" to about 1" (paragraph bridging pages 11 and 12 as applied to claim 3).

The axial compression means are separator plates 212 and 232 (Fig. 2 as applied to claim 4).

The separator plates are electrically conductive (page 7 as applied to claim 5).

Two cells are arranged in series in a bipolar configuration with the separators of adjacent cells being in contact with one another (as applied to claim 6).

The compression pad comprises carbon and an elastomeric material (paragraph bridging pages 7 and 8 and prior art claims 1 and 6 as applied to claim 7).

WO '851 discloses an electrochemical cell comprising a PEM 202 having a first face and second face, anode 204 and cathode 206 on respective first and second sides of the PEM 202, metal screen 218 defining a first fluid cavity placed in contact with anode 204, an electrically-conductive spring-like porous pad 230 defining a second fluid cavity which is electrically conductive and has an inner face in contact with cathode 206,

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means 212/216/214 functioning as a first cell frame and means 232/224/226/236 functioning as a second cell frame (Admitted prior art Fig. 2 as applied to claim 8).

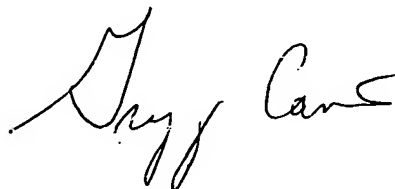
The compression pad includes carbon (page 8 as applied to claim 9).

The compression pad comprises carbon and an elastomeric material (paragraph bridging pages 7 and 8 and prior art claims 1 and 6-7 as applied to claim 10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (571) 272-1283. The examiner can normally be reached on Monday to Thursday from 9 a.m. to 6 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. FAXES received after 4 p.m. will not be processed until the following business day. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregg Cantelmo
Primary Examiner
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A handwritten signature in black ink, appearing to read "Gregg Cantelmo", is written over a light gray grid background.

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July 21, 2005.